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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/089,810      | 08/05/2002  | Lutz Brandt          | FA-1068             | 3040             |

7590 08/25/2005

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EXAMINER

TSOY, ELENA

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1762

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/089,810

Applicant(s)

BRANDT ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10,11,13,14 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10,11,13,14 and 16-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Response to Amendment***

1. Amendment filed on 7/5/2005 has been entered. Claims 10-11, 13-14, 16-24 are pending in the application.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10, 11, 13, 14, 16-22 stand rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Betz et al (US 6,261,645) and Bishop et al (US 4,609,718, which corresponds to EP 204161) for the reasons of record set forth in paragraph 5 of the Office Action mailed on 3/30/2005 because 5-90 wt % of bonders and 0 to 70 wt % of reactive diluents in Betz et al are based on **total weight** of the **coating composition** (See column 8, lines 14-21), i.e. 5.6-100 wt % of binders based on **resin solids** as required by amendment.

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5. Claims 23, 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Betz et al (US 6,261,645) and Bishop et al (US 4,609,718, which corresponds to EP 204161) for the reasons of record set forth in paragraph 6 of the Office Action mailed on 3/30/2005.

***Response to Arguments***

6. Applicants' arguments filed 7/5/2005 have been fully considered but they are not persuasive.

(A) Applicants argue that Betz et al. teach away from Applicants' claimed invention. Betz et al. disclose a broad weight percentage range of binder from 5% to 90% based on the overall weight of the coating composition (col. 8, lines 15-21). Applicants note that Betz et al. only exemplify, at most, 79.2 wt% of binder in their coating compositions, with weight percentage being based on resin solids (see table 1, examples 1 and 4., based on the calculation that 76.0 parts Viaktin or Laromee 8861 and 20.0 parts hexanediol diacrylate equals 96.0 parts resin solids).

The Examiner respectfully disagrees with this argument because Betz et al. teach in its disclosure 5-90 wt % of bonders and 0 to 70 wt % of reactive diluents based on **total weight** of the coating composition (See column 8, lines 14-21), i.e. 5.6-100 wt % of binders based on resin solids as required by amendment.

It is held that patents are relevant as prior art for all they contain including prior art's **broad disclosure**. See MPEP 2123. See Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). **Disclosed examples** and preferred embodiments do not constitute a *teaching away* from a broader disclosure or

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nonpreferred embodiments. See MPEP 2123. Therefore, Pettus does teach that the process can be used for coating a chrome plated substrate, may be with inferior results than for aluminum substrates. But again, it is expected since according to Applicants "It is well known in the art that chrome surfaces are more difficult to coat than aluminum".

Thus, Betz et al. do not teach away from Applicants' claimed invention.

(B) Applicants argue that the Examiner has failed to provide any reason why one of ordinary skill in the art would be motivated to use diisocyanates with eight carbon atoms to produce the aliphatic urethane methacrylates utilized in Applicants' claimed process based on the disclosure of Bishop et al.

Betz et al expressly teach the use of di- or polyisocyanate, e.g commercially customary **isocyanurate** trimer of hexamethylene (hexane) diisocyanate (claimed polyisocyanate based on an acyclic aliphatic diisocyanate having 8 C atoms) for making urethane (meth)acrylates though in non-preferred embodiments (See column 13, lines 15-20).

It is held that patents are relevant as prior art for all they contain including prior art's broad disclosure. See MPEP 2123. Disclosed examples and preferred embodiments do not constitute a **teaching away** from a broader disclosure or **nonpreferred embodiments**. See MPEP 2123.

Therefore, even without relying on Bishop et al, the use of di- or polyisocyanate, e.g commercially customary **isocyanurate** trimer of hexamethylene (hexane) diisocyanate (claimed polyisocyanate based on an acyclic aliphatic diisocyanate having 8 C atoms) for making urethane (meth)acrylates would have been obvious to one of ordinary skill in the art.

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Addition to this, Betz et al teach that **these various preparation processes** for the polyurethane acrylates **are known** (cf. e.g. EP-A-204 161) and therefore do not require any more detailed description (See column 7, lines 52-54). Bishop et al (which corresponds to EP 204161) teach that **any organic diisocyanate** can be used to form the acrylate-terminated oligomers, such as a diisocyanate in which a linear aliphatic chain containing at least 6 carbon atoms separates the two isocyanate groups (i.e. including an acyclic aliphatic diisocyanate having 8 C atoms) (See column 3, lines 65+).

### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-142323. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy  
Primary Examiner  
Art Unit 1762

**ELENA TSOY**  
**PRIMARY EXAMINER**  
*ETsoy*

August 23, 2005